UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENICHI ASADA

Appeal 2007-2458
Application 10/006,577
Technology Center 2600

Decided: October 23, 2007

Before: JOSEPH F. RUGGIERO, ROBERT E. NAPPI and KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1-4, 6-10, 12, and 14. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF CASE

Appellant discloses a cellular phone and related systems where the cellular phone can be turned on by a sender even when the power of the cellular phone was in the off state. (Specification 1:9-15).

Appellant has grouped the claims into two groups. Group 1 consisting of, independent claims 1, 3, 6, and 9, and Group 2, consisting of dependent claims 2, 4, 7, 8, 10, 12, and 14. Appellant's statements on page 15 of the brief do not specify why the claims in Group 2 are separately patentable from the claims in Group 1. As such, we do not consider Appellant to have separately grouped the claims in Group 2. Thus, in accordance with 37 C.F.R. § 41.37 (c)(1)(vii) we group all of the rejected claims together and we take claim 1 to be representative of the claims, which reads as follows:

> 1. A notification system for communicating between a sender cellular phone and a receiver cellular phone comprising:
> a system configuration for allowing said sender cellular phone to transmit an ON state indication signal indicating to switch ON a main power source of said receiver cellular phone through a radio wave to said receiver cellular phone being in an OFF state,
> such that said main power source of said receiver cellular phone is remotely turned ON.

The Examiner rejected claims 1-4, 6-10, 12, and 14 under 35 U.S.C. § 103(a).

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Fukuda	US 6,169,905 B1	Jan. 2, 2001
Gillig	US 4,989,230	Jan. 29, 1991

Appellant contends that the Examiner erred in indicating that the claimed subject matter would have been obvious. More specifically, Appellant has argued that the limitations in the independent claims are not disclosed or suggested in any cited portion of Fukuda or Gillig. (Br. 8). Appellant also argues that the disclosure of Fukuda fails to teach or suggest

that any signal is sent to a terminal to instruct the terminal to turn on its power, as required by the claims. The Examiner finds that all of the elements of the claims are taught or suggested by the combination of Fukuda and Gillig and that signaling is sent that causes the power of a receiving cellular phone to be turned on. (Answer 12).

We affirm.

ISSUE

Has Appellant shown that the Examiner erred in establishing that the combination of the cited references teach or suggest all of the disputed elements of the independent claims 1, 3, 6, and 9?

FINDINGS OF FACT

1. Appellant discloses a notification system that can notify a cellular phone of the receiving party, even if that receiving party's cellular phone is "turned off." (Specification 2:19-22).

2. The notification system includes a sender cellular phone that communicates through a plurality of base stations to contact a receiver cellular phone to be notified. (Specification 10:3-11; Fig. 1; elements 100, 1, 40, & 5).

3. The receiver cellular phone includes a power ON information detecting section and a power source section. The "main power source" is not illustrated in the drawings of the instant application. The "main power source" must be a subset of the power source section because the Specification details that power source section supplies power to sections of the receiver cellular phone so that they "remain in an active state, even if the

main power source is turned OFF." (Specification 11:11-25; Fig. 2; elements 5, 7, & 8).

4. In the receiver cellular phone, the synchronization establishing section and the power-ON information detecting section always remain in the power-ON state even if the main power source is set to be in a power-OFF state. (Specification 13:2-6).

5. Fukuda is directed to methods for controlling a digital cordless telephone system having a plurality of master stations and a plurality of remote stations. (Col. 5, ll. 11-30; Fig. 4, elements 1-8).

6. The main master station in Fukuda successively transmits a control signal, where the remote stations are set in the reception standby mode. (Col. 7, ll. 55-61; col. 8, ll. 8-23; Figs. 9A-9D).

7. Fukuda discloses that the control signal is transmitted to the remote stations in accordance with a predetermined format. That format is set when each remote station is set into a reception standby mode through the master station. Each remote station detects the timing at which they receive the control signal and thus modifies the times in which they are in the reception standby mode. In other words, the periodicity of when the remote stations are in reception standby mode is set by the control signal. (Col. 1, l. 65 – col. 2, l. 18; col. 8, ll. 24-39).

8. Appellant has not argued that combination of Fukuda or Gillig is improper and has stated only that Gillig fails to cure the perceived deficiencies of Fukuda.

PRINCIPLES OF LAW

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellant to overcome the prima facie case with argument and/or evidence. *See Id.*

The Examiner's articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The analysis need not seek out precise teachings directed to the specific subject matter of the claim but can take into account the inferences and the creative steps that a person of ordinary skill in the art would employ. *KSR Int'l Co. v. Teleflex Inc.,* 127 S.Ct. 1727, 1741 (2007).

The claims on appeal should not be confined to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (*en banc*). During ex parte prosecution, claims must be interpreted as broadly as their terms reasonably allow since Applicants have the power during the administrative process to amend the claims to avoid the prior art. *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989).

ANALYSIS

Appellant has argued that the timing control in Fukuda is made to synchronize with the receipt of the control signal. We agree, but do not find this to be distinguishing, when compared to the text of the independent claims. Claims 1 and 6 recite "an ON state indication signal," claim 3 recites "power-ON information," and claim 9 recites "a signal from a base station for switching to be in an ON state." These recitations are not the

same as a "power-ON signal embedded in the control signal," as argued by Appellant since the claims do not require any embedding of signals.

The signals and information recited in the independent claims require no more than that they indicate that the state of the receiving cellular phone should be changed. These elements read directly on an initial control signal in Fukuda that is sent from the master station to the remote station to establish the timing of when the remote stations enter the reception standby mode. (Finding of Fact 7). That initial control signal indicates that sections should be energized to receive subsequent signals at predetermined intervals; the fact that this initial signal does not cause the remote station to turn on and stay on indefinitely, as disclosed but not claimed by Appellant, is not dispositive. Fukuda teaches the sending of a signal from the master station to the remote station that indicates that the remote station should be in a remote standby mode, where we find that the above-noted signals and information recited in the independent claims read on that disclosure. We find the Appellant's arguments directed to commands or embedded signals to be immaterial, in view of the elements recited in the independent claims.

In addition, the Appellant and the Examiner dispute the meaning of language found in the Abstract of Fukuda that the "remote station turns on and off a power supply of its reception unit on the basis of the control signal." Since we find that the control signal does control the remote station's entry into the remote standby mode, so that the reception station need not be set in the on-state constantly, we also find the discussion whether the interpretation of the Abstract is contrary to the teachings of the Specification to be moot.

With respect to the on and off states of the main power source, Appellant argues that the reception units of Fukuda could not receive any control signal instructing it to turn on the power when that reception unit is in the powered off state and Fukuda is concerned only with the turning on and off of the reception unit and not the main power. We disagree.

The main power source recited in the independent claims is not the only power source found in the receiver cellular phone, (Finding of Fact 3), and all of the power in the receiver cellular phone is not turned off in the OFF-state (Finding of Fact 4). Appellant's disclosure indicates that the main power source is a subset of the power source section, so that signals can still be received, even when the receiver cellular phone is in the off-state. In this respect, the disclosures of Fukuda and the instant application are the same. While the independent claims recite a "*main* power source," we have no evidence before us that the reception unit power of Fukuda is not a main power source. Given the power savings described in Fukuda by employing the intermittent standby mode, the power to the reception unit may be a main power source for the reception station overall.

CONCLUSION OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-4, 6-10, 12, and 14.

DECISION

The Examiner's rejection of claims 1-4, 6-10, 12, and 14 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Steven I. Weisburd Esq.
Dickstein Shapiro Morn & Oshinsky LLP
1177 Avenue of the Americas
41st Floor
New York, NY 10036-2714